

ESTTA Tracking number: **ESTTA165339**

Filing date: **09/27/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046637
Party	Defendant Living Spaces Furniture, LLC
Correspondence Address	Michael G. Frey Greenbaum Doll & McDonald PLLC 2800 Chemed Center, 255 East Fifth Street Cincinnati, OH 45202-4728 UNITED STATES lek@gdm.com
Submission	Motion to Dismiss 2.132
Filer's Name	Michael G. Frey
Filer's e-mail	mgf@gdm.com
Signature	/michael.g.frey/
Date	09/27/2007
Attachments	living spaces motion.pdf (12 pages)(345807 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,088,627

MATTRESS FIRM, INC.,

Petitioner,

v.

LIVING SPACES FURNITURE, LLC,

Registrant.

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Cancellation No. 92046637

REGISTRANT’S MOTION FOR JUDGMENT UNDER RULE 2.132(a)

Registrant, Living Spaces Furniture, LLC (“Registrant”), the owner of U.S. Trademark Registration No. 3,088,627, for the mark BUY IT TODAY, SLEEP ON IT TONIGHT, hereby moves, pursuant to 37 CFR 2.132(a), for dismissal of this cancellation proceeding with prejudice on the ground of the failure of the Petitioner, Mattress Firm, Inc., to prosecute the action.

Under Rule 2.132(a), judgment may be rendered against the petitioner in a cancellation proceeding (1) if the petitioner fails to take testimony or offer any other evidence by the close of its testimony period and (2) if the petitioner cannot establish good and sufficient cause as to why judgment should not be rendered against it.

The first element is present in this case. As set in the Board’s scheduling order of November 17, 2006, Petitioner’s testimony period closed September 3, 2007, and Petitioner has not entered any evidence into the record.

The second element is also present. The Board has recognized that a showing of good and sufficient cause under Rule 2.132(a) is the equivalent of a showing of “excusable neglect” required under FED. R. CIV. P. 6(b) to reopen the petitioner’s testimony period. *See PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 U.S.P.Q.2d 1860, 1860–61 (T.T.A.B. 2002). This determination is an equitable one, and involves consideration of a number of factors and circumstances surrounding a party’s delay or failure to act. In this case, the facts show that Petitioner’s failure to take testimony was due to circumstances wholly within its control, and therefore that Petitioner’s failure to act is not excusable.

Although the parties were engaged in settlement negotiations prior to the close of Petitioner’s testimony period, the mere existence of such negotiations does not excuse Petitioner’s failure to act by the deadline. *See Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 U.S.P.Q.2d 1858, 1859 (T.T.A.B. 1998). Further, although counsel for Registrant raised the possibility of seeking suspension of the proceeding to allow settlement negotiations to take place in an e-mail a few days before the close of the testimony period, counsel for Petitioner did not acknowledge the offer in his response, nor did counsel for Petitioner raise the issue of suspension again until September 13, 2007, ten days after its testimony period closed. *See Exhibit A.*

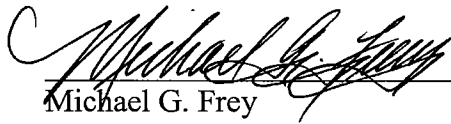
Even if this e-mail exchange caused Petitioner to mistakenly believe that proceedings were suspended or that Registrant would file a request to suspend proceedings — a conclusion that Registrant submits is unwarranted — such a mistaken belief does not excuse Petitioner’s failure to act by the end of its testimony period. *See PolyJohn*, 61 U.S.P.Q.2d at 1862 (explaining that, even in cases where there is an understanding between the parties to reset trial

Registrant's Motion for Judgment under Rule 2.132(a)
Cancellation No. 92046637
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dates, it is "incumbent upon petitioner, as the party with the burden of moving forward, to comply with the requirements of [the Trademark Rules of Practice], or run the risk of suffering dismissal for want of prosecution").

In light of the foregoing, Registrant respectfully requests that the Board grant its motion for judgment under Rule 2.132(a), and dismiss the petition for cancellation with prejudice.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Michael G. Frey", is written over a horizontal line.

Michael G. Frey

Lori Krafte

GREENEBAUM DOLL & MCDONALD PLLC

2800 Chemed Center

255 East Fifth Street

Cincinnati, Ohio 45202

(513) 455-7600


(513) 455-8500 (facsimile)

Counsel for Registrant Living Spaces, LLC

Dated: September 27, 2007

CERTIFICATE OF FILING

I certify that the foregoing REGISTRANT'S MOTION FOR JUDGMENT UNDER RULE 2.132(a) is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 27th day of September, 2007.

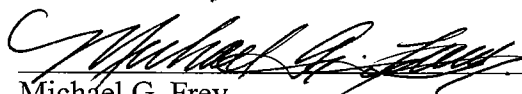


Michael G. Frey

CERTIFICATE OF SERVICE

I hereby certify that the foregoing REGISTRANT'S MOTION FOR JUDGMENT UNDER RULE 2.132(a) has been sent via regular U.S. Mail this 27th day of September, 2007, to the following:

Anthony F. Matheny, Esq.
John F. Luman III, Esq.
Bracewell & Giuliani LLP
P.O. Box 61389
Houston, Texas 77208-1389



Michael G. Frey

Frey, Michael G.

From: Frey, Michael G.
Sent: Wednesday, August 29, 2007 11:20 AM
To: Luman, John
Subject: Mattress Firm v. Living Spaces

John:

I have finally had the opportunity to discuss settlement options with representatives of my client. I can report that Living Spaces is indeed open to settling this matter through some type of coexistence agreement.

[Redacted material related to settlement discussions]

If your client has an alternate proposal regarding coexistence, please let me know the particulars so that I can discuss them with Living Spaces.

Finally, in light of the upcoming deadlines in the proceeding, I suggest that we suspend the opposition to allow the parties time to negotiate toward an acceptable agreement. If your client is agreeable, we can then work out the specifics of the suspension, scheduling order and discovery response deadline.

Very truly yours,
Michael G. Frey
Greenebaum Doll & McDonald PLLC
2800 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202-4728
Phone: 513-455-7678
E-Mail: mgf@gdm.com

9/27/2007

Frey, Michael G.

From: Luman, John [John.Luman@bgllp.com]
Sent: Thursday, August 30, 2007 1:17 PM
To: Frey, Michael G.
Subject: RE: Mattress Firm v. Living Spaces

Michael

Thanks for your email. My client contact is on vacation until next week. I will get back with you after speaking with her.

John

John F. Luman III | Partner | Bracewell & Giuliani LLP
711 Louisiana Street, Suite 2300 | Houston, Texas | 77002-2770
T: 713.221.1596 | F: 713.437.5398
john.luman@bgllp.com | www.bgllp.com

From: Frey, Michael G. [mailto:MGF@GDM.com]
Sent: Wednesday, August 29, 2007 10:20 AM
To: Luman, John
Subject: Mattress Firm v. Living Spaces

John:

I have finally had the opportunity to discuss settlement options with representatives of my client. I can report that Living Spaces is indeed open to settling this matter through some type of coexistence agreement.

[Redacted material related to settlement discussions]

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Michael G. Frey
Greenebaum Doll & McDonald PLLC
2800 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202-4728
Phone: 513-455-7678
E-Mail: mgf@gdm.com

The following warning is required by the IRS whenever tax advice is given. If this email contains no direct or indirect tax advice, the warning is not applicable.

As a result of perceived abuses, the Treasury has recently promulgated Regulations for practice before the IRS. These Circular 230 regulations require all attorneys and accountants to provide extensive disclosure when providing certain written tax communications to clients. In order to comply with our obligations under these Regulations, we would like to inform you that since this document does not contain all of such disclosure, you may not rely on any tax advice contained in this document to avoid tax penalties, nor may any portion of this document be referred to in any marketing or promotional materials.

This message has been sent from a law firm and may contain information which is confidential or privileged. If you are not the intended recipient, please advise the sender immediately by reply e-mail and delete this message and any attachments without retaining a copy. Please advise immediately if you or your employer do not want us to use Internet e-mail for future messages of this kind. Thank you.

9/27/2007

Frey, Michael G.

From: Luman, John [John.Luman@bgllp.com]
Sent: Thursday, September 13, 2007 11:49 PM
To: Frey, Michael G.
Subject: Re: Mattress Firm v. Living Spaces

Michael

Let's pick a time next Thursday, as I am out of the office until then. You let me know what works for you and I'll make it work on my end. Also, should we file something suspending the proceedings?

Thanks.
John

----- Original Message -----

From: Frey, Michael G. <MGF@GDM.com>
To: Luman, John
Sent: Thu Sep 13 09:11:25 2007
Subject: RE: Mattress Firm v. Living Spaces

John:

I'm sorry I didn't get back to you yesterday. I'm still fairly tied up with this other project. If our conversation could wait until tomorrow, that would work better for me. If not, perhaps the best solution would be for you to send an e-mail covering what you want to discuss, as it will be easier for me to fit in an e-mail response than commit to a scheduled call today.

-Michael

From: Luman, John [<mailto:John.Luman@bgllp.com>]
Sent: Thursday, September 13, 2007 7:44 AM
To: Frey, Michael G.
Subject: Re: Mattress Firm v. Living Spaces

Michael

Will you be available to speak with me today?

John

----- Original Message -----

From: Frey, Michael G. <MGF@GDM.com>
To: Luman, John
Sent: Tue Sep 11 15:08:41 2007

9/27/2007

Subject: RE: Mattress Firm v. Living Spaces

John:

Thursday morning could be tricky. I am working on a rather large deadline project that will take up most of my time the rest of the week. I will have a better idea on how things are going at the end of the day tomorrow and will let you know how things are looking then.

-Michael

From: Luman, John [<mailto:John.Luman@bgllp.com>]
Sent: Tuesday, September 11, 2007 3:29 PM
To: Frey, Michael G.
Subject: RE: Mattress Firm v. Living Spaces

Michael

Are you available on Thursday morning to discuss this matter? Let me know a good time for you.

Thanks.
John

From: Luman, John
Sent: Thursday, August 30, 2007 12:17 PM
To: 'Frey, Michael G.'
Subject: RE: Mattress Firm v. Living Spaces

Michael

Thanks for your email. My client contact is on vacation until next week. I will get back with you after speaking with her.

John

John F. Luman III | Partner | Bracewell & Giuliani LLP
711 Louisiana Street, Suite 2300 | Houston, Texas | 77002-2770
T: 713.221.1596 | F: 713.437.5398
john.luman@bgllp.com <<mailto:john.luman@bgllp.com>> | www.bgllp.com
<<http://www.bgllp.com/>>

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E-Mail: mgf@gdm.com <<mailto:mgf@gdm.com>>

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